



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,300	06/26/2001	Manoel Tenorio	020431.0840	2345

7590 11/29/2004

Christopher W. Kennerly  
Baker Botts L.L.P.  
Suite 600  
2001 Ross Avenue  
Dallas, TX 75201-2980

EXAMINER

KRAMER, JAMES A

ART UNIT PAPER NUMBER

3627

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/892,300

Applicant(s)

TENORIO, MANOEL

Examiner

James A. Kramer

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/16/04.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22 and 35 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. In particular, the preamble of the claims sets forth an apparatus, however the body includes only method step limitations. Examiner notes that MPEP 2114 states that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In this case there is no structure to the claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-35 rejected under 35 U.S.C. 102(b) as being anticipated by Mathur et al.

(hereinafter Mathur)

Mathur teaches (reference column 3; line 34 – column 5; line 5) that a search engine provides a search tool which allows users to identify documents of interest using information stored in the index generated by the search engine. In order to identify documents of interest, a user generally configures a query using a client computer. The query may contain query terms which describe, for example, a topic or concept for which the user is interested in finding more

Art Unit: 3627

information. For example, if the user is interested in finding information on Thai cooking, the query terms may include the words "Thai" and "cooking."

The user-configured query is then communicated from the user's client computer to a remote server system executing a search engine. Upon receiving the search query, the search engine executing on the remote server identifies documents (or locations of the documents) which match or satisfy the user query based upon information stored in the index used by the search engine. The search engine may use various techniques to determine documents which are relevant to the search query received from the user's client system. Information identifying the relevant documents or their locations determined by the search engine is then communicated from the search engine server to the user's client computer. The user may then use the information received from the search engine to access one or more of the relevant documents.

In a Web environment, the relevant documents may be web pages which may be identified by URLs. Accordingly, the search engine may communicate a list of URLs of interest to the user to the user's client system in response to the user query. The user may then select one or more URLs from the list of URLs and access web pages corresponding to the selected URLs. When the user selects a URL, the URL request is sent to a web server storing the web page corresponding to the URL, and the web server responds by communicating the requested web page to the user's client computer system. The server executing the search engine may act as a conduit forwarding the selected web page received from the web server to the user client computer system.

While conventional search engines simplify the process of identifying documents containing information of interest to a user, they also compromise the user's privacy. This is

because conventional search engine servers frequently track and/or mine the user's browsing activities and tracking information provided by the user to the search engine. For example, several conventional search engines mine, without the user's permission, information contained in user search queries (which may contain information of a sensitive and private nature) provided to the search engines. Several conventional search engines also track the contents of documents (e.g. web pages) accessed by the user using the search engine. For example, in a Web environment, conventional search engines track the web pages accessed by the user, the content of the web pages, transactions performed by the user using the web pages, and other like information without the user's permission.

The information mined or tracked by conventional search engines is then used to ascertain information about the user's interests, likes/dislikes, the user's shopping preferences, information related to the user's use of the Internet, and other information related to the user and the user's behavior. Since users generally have a tendency to use a particular search engine to perform searching, over a period of time, the particular search engine is capable of building a pretty detailed profile of the user and the user's behavior.

The user information collected by the search engines and the user profile information built by the search engines, which may be sensitive in nature and contain confidential information, may then be distributed or even sold by providers of search engines to entities such as advertising agencies, government agencies, insurance companies, business entities, and the like. This may result in the user being subjected to unsolicited Spam mail messages, unwelcome advertisements, credit card fraud, mail fraud, banking fraud, and other unwelcome activities. As a result, the use of a conventional search engine executing on a remote server can severely

Art Unit: 3627

compromise a user's privacy and security. Further, since the information collected by the search engines is typically stored on a server system which is located at a remote location from the user's computer system, the user has very little control on the collection and dissemination of the information.

***Response to Arguments***

Applicant's arguments filed 9/16/04 have been fully considered but they are not persuasive.

Applicant asserts that the rejection under 35 U.S.C. 112, second paragraph is improper because the scope of the claims would be clear to one of ordinary skill in the art. Examiner asserts that claims contain language that suggests or make optional but does not require steps to be performed or does not limit the claim to a particular structure and therefore does not limit the scope of the claim. Examiner references MPEP 2106 II(C). In particular, Examiner notes that Applicant's use of "operable to" is clearly functional language which fails to further limit the claim. Examiner further notes that "operable" is defined by Webster's New Riverside Dictionary as "able to be used". As such, Examiner asserts that any server is "able to be used" or "operable" for Applicant's invention and thus the claim merely recites any server operating on one or more computers able to perform the claimed limitations..

Applicant further argues that it would be an extreme that any system claim that recites a memory and a processor, the memory storing certain information and the processor operable to perform certain features, would be anticipated by any reference that discloses a memory and a processor because that structure of the claim would be disclosed by the reference (regardless of whether the operations are disclosed). Examiner asserts that this is not an extreme but precisely

Art Unit: 3627

the situation. Applicant's invention is geared towards a method of using an old and well known system (server with computers), not a new apparatus. As a result of the functional term "operable" Applicants limitations do not further define discrete physical structures or materials, instead they outline the "method steps" the physical structure (server) employs.

Examiner notes that without further limiting the structure of the claims, claims 1-22 and 35 are not only rejected under 35 U.S.C. 112, second paragraph but also are clearly anticipated by Mathur.

Applicant further asserts that the rejection under 35 U.S.C. 102 as anticipated by Mathur is improper. Examiner notes that this discussion will be limited to method claims 22-33 and the means plus function claim 34, as claims 1-22 and 35 have been described in detail above.

Applicant asserts that Mathur discusses a web environment and not product database. Examiner notes that this argument fails in that Mathur teaches the ability to information related to the interests of the user. Examiner notes that it would be clear to one of ordinary skill in the art that computer users utilize the Internet and web environment in order to shop for items. Therefore the search engine of Mathur clearly includes searching databases of products. Examiner notes that because the search engine of Mathur also searches other databases does not mean the references does not anticipate Applicant's invention.

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., > *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) "The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps.";< *Genentech, Inc. v.*

Art Unit: 3627

Chiron Corp., 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997). "Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.; *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) "Comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts".

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).




Art Unit: 3627

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer  
Examiner  
Art Unit 3627

jak

  
Richard Chilcot  
Supervisory Patent Examiner  
Technology Center 280  
360